

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

CORDIS CORPORATION,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 97-550-SLR
	)	(consolidated)
MEDTRONIC AVE, INC., BOSTON	)	
SCIENTIFIC CORPORATION and	)	
SCIMED LIFE SYSTEMS, INC.,	)	
	)	
Defendants.	)	
	)	
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MEDTRONIC AVE, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 97-700-SLR
	)	
CORDIS CORPORATION, JOHNSON &	)	
JOHNSON and EXPANDABLE GRAFTS	)	
PARTNERSHIP,	)	
	)	
Defendants.	)	
	)	
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BOSTON SCIENTIFIC CORPORATION,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 98-19-SLR
	)	
ETHICON, INC., CORDIS CORPORATION	)	
and JOHNSON & JOHNSON	)	
INTERVENTIONAL SYSTEMS CO.,	)	
	)	
Defendants.	)	
	)	
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CORDIS CORPORATION,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 98-197-SLR
	)	
BOSTON SCIENTIFIC CORPORATION	)	
and SCIMED LIFE SYSTEMS, INC.,	)	
	)	
Defendants.	)	

## MEMORANDUM ORDER

At Wilmington, this 15th day of May, 2002, having reviewed the parties' motions for reconsideration of the court's opinion and order dated March 28, 2002;

IT IS ORDERED that:

1. BSC's motion for reconsideration of its motion for a new trial on infringement of the "substantially uniform thickness" limitation (D.I. 1130) is granted. Although the prosecution history of United States Patent No. 4,739,762 (the "'762 patent") had been reviewed by the court for purposes of claim construction, the issue of whether the doctrine of prosecution history estoppel precluded Cordis from seeking infringement by equivalence was not submitted by defendants for the court's consideration until trial had commenced. (D.I. 947, 992) Faced with a legal question raised for the first time during trial, the court declined to submit the question to the jury. BSC argues that the court committed legal error by not submitting to the jury a detailed verdict form that itemized the jury's infringement analysis on a limitation-by-limitation basis. The court finds that it did commit legal error in this regard.

As an initial matter, the court finds that both defendants submitted detailed jury instructions and only accepted the final version of the jury instructions after the court, consistent with

Cordis' position, rejected the more lengthy, complicated versions proffered by defendants. Therefore, contrary to Cordis' argument, neither defendant waived its position regarding the proper form of jury verdict.

As to the merits of BSC's motion, the court concludes that BSC is entitled to a new trial on infringement of the "substantially uniform thickness" limitation. As explained by the Federal Circuit in Litton Sys., Inc. v. Honeywell, Inc., 140 F.3d 1449 (Fed. Cir. 1998),

[a]lthough an appellate court must sustain a jury verdict against a JMOL if there are **any** reasonable grounds for the verdict, an appellate court must also vacate a jury verdict and remand for a new trial if a jury may have relied on an impermissible basis in reaching its verdict.

Id. at 1465 (emphasis in original) (citations omitted). See also Carden v. Westinghouse Elec. Corp., 850 F.2d 996, 1000 (3d Cir. 1988) ("In our jurisprudence it has been established that a general verdict must be set aside where the jury has been instructed that it could rely on two or more independent grounds or claims and one of those grounds or claims turns out to be insufficient."); Molten Metal Equip. Innovations, Inc. v. Metaullics Sys. Co., 130 F. Supp. 917, 923 (N.D. Ohio 2001).

In this case, although the court concluded that there was sufficient evidence to support a finding of literal infringement of the "substantially uniform thickness" limitation (thus meeting

the JMOL standard), it is possible that the jury relied on the doctrine of equivalents for its finding of infringement of that limitation. Under these circumstances, where the court has found that Cordis is not entitled to any range of equivalents for the "substantially uniform thickness" limitation, it was not harmless error for the court to have given the jury a general verdict form. Therefore, the jury's verdict as to BSC's infringement of claim 23 of the '762 patent is vacated, and a new trial shall be conducted to determine whether BSC has infringed the "substantially uniform thickness" limitation.

2. AVE's motion for reconsideration of its motion for a new trial (D.I. 1131) is granted. Pursuant to Fed. R. Civ. P. 50(c)(1), the court is required to address the merits of AVE's motion for a new trial in the event that the Federal Circuit reverses the grant of AVE's motion for judgment as a matter of law. AVE's motion for a new trial is granted in part and denied in part for the following reasons:

a. **"Essence of the Invention" Arguments.** AVE argues that it is entitled to a new trial because Cordis improperly compared the AVE stents to the "essence of the invention" of the '762 patent and United States Patent No. 5,195,984 (the "'984 patent") rather than to the asserted claims. The Federal Circuit has stated that it is entirely appropriate to use the "essence of the invention" to describe the doctrine of equivalents. See

London v. Carson, Pirie Scott & Co., 946 F.2d 1534, 1538 (Fed. Cir. 1991) ("[T]he patentee should not be deprived of the benefits of his patent by competitors who appropriate the essence of an invention while barely avoiding the literal language of the claims."); Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567 (Fed. Cir. 1983) ("Though applicable elsewhere, e.g., in determining infringement under the doctrine of equivalents, there is no legally recognized 'essence' of the invention applicable in determining validity."). Consequently, the court included the following description of the infringement analysis in its charge to the jury:

On the other hand, the patent owner should not be deprived of the benefits of his patent by competitors who appropriate the essence of an invention while barely avoiding the literal language of the patent claims.

(D.I. 1115)

In the absence of a limitation-by-limitation analysis of the asserted claims and an instruction by the court to perform such an analysis, Cordis' references to the "essence of the invention" would perhaps be misleading to a jury. During the AVE trial, however, Cordis presented a detailed comparison of the asserted claim limitations to the AVE stents through the testimony of Drs. Buller and Collins. (D.I. 960 at 604-719; D.I. 962 at 1255-1305) Furthermore, the court instructed the jury to perform a limitation-by-limitation analysis to determine infringement (D.I.

1115), and the court must presume that the jury followed its instructions. See Jones v. United States, 527 U.S. 373, 401 (1999). Thus, because the court finds that the parties and the court presented the jury with the correct analysis to determine infringement under the doctrine of equivalents and that Cordis' references to the "essence of the invention" were not prejudicial, AVE is not entitled to a new trial on these grounds.<sup>1</sup>

b. **"Building Block" Arguments.** AVE also contends that it is entitled to a new trial because Cordis compared the AVE stents to the "building block" rather than to the asserted claims of the '762 and '984 patents. "Infringement, literal or by equivalence, is determined by comparing an accused product not with a preferred embodiment described in the specification, or with a commercialized embodiment of the patentee, but with the properly and previously construed claims in suit." SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121 (Fed. Cir. 1985).

Although the term "building block" does not appear in the patents, a completely half-slotted stent is not inconsistent with the patent claims as construed by the court. Cordis used its

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<sup>1</sup>AVE also contends that Cordis contributed to jury confusion by referring to the "essence" of United States Patent No. 4,733,665 (the "'665 patent"), which was not asserted at trial. The court agrees with Cordis that testimony regarding the '665 patent was limited to establishing a priority date for the '762 patent, and that any references by Cordis to the "essence" of the '665 patent were not prejudicial or cause for jury confusion.

"building block" analogy appropriately, that is, in conjunction with a limitation-by-limitation comparison of the patent claims to the AVE stents. Furthermore, the court permitted AVE to respond to Cordis' use of the "building block" analogy through cross-examination, and concludes that AVE was not unduly prejudiced by it.<sup>2</sup> (D.I. 959 at 422-23) AVE's motion for a new trial on this basis is denied.

c. **Lack of a Detailed Verdict Form.** AVE contends that a new trial is warranted because the court did not use a limitation-by-limitation verdict form to preclude the jury from finding literal infringement of the "plurality of slots formed therein" limitation pursuant to the court's grant of summary judgment prior to trial, and infringement by equivalence of the "substantially uniform thickness" limitation pursuant to the court's finding of prosecution history estoppel after trial. The court finds that, because Cordis did not present a literal infringement argument regarding the "plurality of slots formed therein" limitation at trial,<sup>3</sup> AVE is not entitled to a new trial

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<sup>2</sup>Because the "building block" analogy was used to illustrate infringement of the '762 patent and not the '984 patent, the court appropriately limited AVE's cross-examination of Dr. Schatz regarding it. (D.I. 962 at 1130-31)

<sup>3</sup>Significantly, Dr. Collins specifically stated that Cordis was alleging infringement of that limitation **only** under the doctrine of equivalents:

Q. Just to make sure that is clear, I understand you to be saying there is an

on infringement of that limitation. For the reasons stated above regarding BSC's motion for a new trial, however, AVE's motion for a new trial on infringement of the "substantially uniform thickness" limitation is granted in the event that the Federal Circuit reverses the court's grant of judgment as a matter of law.

d. **Verdict Against the Weight of the Evidence.** AVE's motion for a new trial based on the all-inclusive argument that Cordis' various litigation strategies caused the jury to disregard the clear weight of the evidence is denied.

3. Cordis' renewed motion for entry of judgment dismissing its claims against AVE on United States Patent Nos. 5,902,332 (the "'332 patent") and 5,102,417 (the "'417 patent") (D.I. 1132) is granted as follows:

a. Cordis' and AVE's claims regarding infringement of claims 1, 3 and 5 of the '332 patent and of claims of the '417 patent are dismissed with prejudice.

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equivalent. But my question was, AVE's products do not literally have slots formed therein. Correct, Dr. Collins?

A. They do not literally have slots formed therein, given the definition of slots formed therein, but they have an equivalent.

(D.I. 962 at 1334)

b. AVE's claims regarding validity and enforceability of claims 1, 3 and 5 of the '332 patent and of claims of the '417 patent are dismissed without prejudice.

4. Cordis' motion for reargument of the grant of a new BSC damages trial (D.I. 1135) is denied. The court finds that BSC did not unconditionally stipulate that the AVE stents infringed the asserted claims of the '762 and '984 patents.

5. Cordis' motion for reargument of the denial of an injunction against BSC with leave to renew or, in the alternative, for an order under Fed. R. Civ. P. 54(b) directing the entry of judgment on Cordis' claims against AVE (D.I. 1133) is granted in part and denied in part. Because the court granted BSC's motion for a new trial on infringement of the "substantially uniform thickness" limitation, Cordis is not entitled to entry of a permanent injunction against BSC at this time. Because all issues concerning AVE have been finally adjudicated and there is no just cause for delay,<sup>4</sup> the court will enter judgment as to AVE pursuant to Fed. R. Civ. P. 54(b).

6. The retrial of infringement of the "substantially uniform thickness" limitation and damages as to BSC is stayed

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<sup>4</sup>An immediate appeal as to AVE may eliminate the need to conduct a retrial on the outstanding issues regarding BSC. Furthermore, an immediate appeal would expedite the resolution of a related case, Cordis Corp. v. Medtronic AVE, Inc., Civil Action No. 00-886-SLR.

pending the resolution of the appeal of issues concerning AVE by the Federal Circuit.

Sue L. Robinson  
United States District Judge